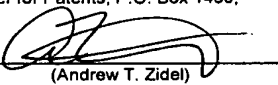


I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the U.S. Postal Service on the date shown below with sufficient postage as First Class Mail, in an envelope addressed to:
 MS Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450,
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 Dated: May 25, 2007 Signature: 
 (Andrew T. Zidel)

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Docket No.: SONYJP 3.3-1245 DIV I
 (PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
 Fumitake Yodo

Application No.: 09/923,702

Confirmation No.: 1747

Filed: August 7, 2001

Art Unit: 3627

For: TERMINAL DEVICE, ACCOUNTING
 SYSTEM, AND DATA PROCESSING
 METHOD

Examiner: C. R. Buchanan

APPELLANT'S REPLY BRIEF ON APPEAL

MS Appeal Brief - Patents
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

Dear Sir:

This Reply Brief is responsive to the Examiner's Answer mailed March 29, 2007.

RELATED APPEALS AND INTERFERENCES

As explained in the Corrected Appeal Brief of August 2, 2006, the instant application is a divisional of U.S. Patent Application No. 09/600,509 ("Parent Application"), filed July 17, 2000. An Appeal Brief in the Parent Application was filed on January 17, 2006, an Examiner's Answer was filed on April 19, 2006, and a Reply Brief was filed on June 16, 2006, along with a request for an oral hearing. As of the date of this corrected appeal brief, an appeal number has not been assigned in the Parent Application.

Another divisional application of the Parent Application; namely, U.S. Patent Application No. 09/923,618 ("Sibling Application") was filed on August 7, 2001. An Appeal Brief in the Sibling Application was filed on November 22, 2004, and an Examiner's Answer was filed on February 17, 2005. A request for an oral hearing was filed on March 3, 2005. An amended Appeal Brief was filed on May 4, 2007, in response to the Notice of Non-Compliant Appeal Brief dated April 4, 2007. As of the date of the instant reply brief, an appeal number has not been assigned in the Sibling Application.

STATUS OF CLAIMS

As noted in the Corrected Appeal Brief, the instant application was originally filed with 12 claims and a Preliminary Amendment canceling claims 1-7 and 10-12. Claims 8 and 9 were amended by the Amendment mailed July 18, 2002, and by the Amendment mailed December 19, 2002. Claim 8 was cancelled and claim 9 was amended by the Amendment mailed July 31, 2003. Claim 9 was amended by the Amendment mailed December 15, 2003, and by the Amendment mailed June 25, 2004. A Response, without any claim amendments, was mailed November 22, 2004, and an Advisory Action maintaining the final rejection of October 12,

2004, was mailed December 6, 2004. Claim 9, the sole claim pending in this application, stands finally rejected and is the basis of this Appeal.

THE GROUND OF REJECTION IN VIEW OF THE EXAMINER'S ANSWER

Claim 9, which is the sole claim pending in this application, stands finally rejected. As noted in the Examiner's Answer the rejection of claim 9 under 35 U.S.C. § 103(a) over Peterson '020 in view of "How Computers Work," by Ron White, copyright 1999 ("How Computers Work") has been withdrawn. Thus, the sole remaining rejection of claim 9 is in view of Peterson '020 under 35 U.S.C. § 103(a).

ARGUMENTS

Appellant submits this reply to address an issue presented by the Examiner's Answer; namely, whether consideration and patentable weight should be given to the "when the detector detects..." language of the claim. This issue will be addressed in detail below.

I. THE "WHEN THE DETECTOR DETECTS..." LANGUAGE OF THE CLAIM SHOULD BE GIVEN PATENTABLE WEIGHT

Independent claim 9, as presented on appeal, recites:

An accounting system including an accounting center and a terminal device communicating with the accounting center, the terminal device comprising:

a first memory configured to store accounting points, the first memory being built-in in the terminal device;

a second memory configured to store distributed information distributed from an external source;

a first controller configured to update the accounting points stored in the first memory and to update attributes of the distributed information when the distributed information is stored in the second memory;

a second controller configured to transmit a request for purchasing the accounting points to the accounting center and to update the accounting points stored in the first memory based on an accounting processing corresponding to the accounting points executed at the accounting center; and

a detector configured to detect whether a portable device with a storage medium is connected to the terminal device, wherein

when the distributed information is stored in the second memory, the first controller updates the attributes of the distributed information to an unavailable state and updates the accounting points stored in the first memory based on the distributed information, and when the accounting points are not updated correctly, the second controller transmits the request for purchasing the accounting points to the accounting center and updates the accounting points, and the first controller updates the attributes of the distributed information from the unavailable state to an available state, and

when the detector detects that the portable device is connected to the terminal device, the first controller updates attributes of information stored in the storage medium of the portable device from an unavailable state to an available state after the accounting points are updated correctly, and

the accounting center comprising:

a third controller configured to carry out an other accounting processing based on the request for purchasing the accounting points transmitted from the terminal device by the second controller.

(Emphasis added.)

The Examiner's Answer states:

Regarding the additional limitation beginning with, "when the detector...", this limitation is merely

conditional phraseology; therefore, such a phrase is function language having no patentable weight. Also, it is noted the system does not positively recite a portable device is attached to the terminal device.

(Examiner's Answer, Mar. 29, 2007)

The Examiner's Answer is correct in noting that the portable device is not positively recited in the body of the claim. However, this does not provide a basis for simply ignoring the limitation "when the detector detects that the portable device is connected to the terminal device, the first controller updates attributes of information stored in the storage medium of the portable device from an unavailable state to an available state after the accounting points are updated correctly." This limitation functionally describes, and positively recites, how the first controller operates when the detector detects a connection of the portable device to the terminal device. It is not "merely conditional phraseology" as asserted in the Examiner's Answer.

It has long been acknowledged that a functional limitation in a claim is proper. "In our view, there is nothing intrinsically wrong with the use of such a technique in drafting patent claims." *In re Swinehart*, 439 F.2d 210, 212 (C.C.P.A. 1971.) Furthermore, the *Manual of Patent Examining Procedure* ("M.P.E.P.") states a "functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used." M.P.E.P. § 2173.05(g), 8th ed., Rev. 5 (Aug. 2006) (emphasis added).

This requirement as stated in the M.P.E.P. is fully consistent with *Swinehart* and subsequent decisions. In particular, "we here wish to specifically note that contrary to the Examiner's assertions, functional language in the claims


must be given full weight and may not be disregarded in evaluating the patentability of the subject matter defined employing such functional language." *Ex parte Bylund*, 217 U.S.P.Q. 492, 498 (Bd. App. 1981) (emphasis added).

The rejection of claim 9 in view of *Peterson '020* is fatally deficient as it ignores the aforementioned functional limitation. Appellant submits that *Peterson '020* does not teach or otherwise suggest the claimed limitation. In addition, the rejection supplies no reason whatsoever for modifying *Peterson '020* in order to arrive at the claimed limitation including this limitation.

Accordingly, for this reason and for the other reasons presented in Appellant's Corrected Appeal Brief, it is respectfully submitted that claim 9 is patentably distinct over *Peterson '020*. A reversal of the final rejection of claim 9 by this Honorable Board is respectfully requested.

Dated: May 25, 2007

Respectfully submitted,

By 
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